

REMARKS

This application is believed to be in condition for allowance because the claims are non-obvious and patentable over the cited references. The following paragraphs provide the justification for this belief. In view of the following reasoning for allowance, the Applicant hereby respectfully requests further examination and reconsideration of the subject patent application.

1.0 Rejections under 35 U.S.C. §102(e):

In the Office Action of September 15, 2003, claims 1-9, 11, 13-15, 24-30, 34-45 and 50 were rejected under 35 U.S.C. §102(e), as being anticipated by Appelt et al. ("**Appelt**," U.S. Patent 6,601,026). A rejection under 35 U.S.C. §102(e) requires that the Applicant's invention was described in patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant. To establish that a patent describes the Applicant's invention, *all of the claimed elements of an Applicant's invention must be considered, especially where they are missing from the prior art.* If a claimed element is not taught in the referenced patent, then a rejection under 35 U.S.C. §102(e) is not proper, as the Applicant's invention can be shown to be patentably distinct from the cited reference.

Further, in accordance with both the M.P.E.P., Chapter 2100, and well settled case law, the PTO is to apply to verbiage of the proposed claims the broadest reasonable meaning of the words in their ordinary usage as they would be understood by one of ordinary skill in the art, ***taking into account whatever enlightenment by way of definitions or otherwise that may be afforded by the written description contained in applicant's specification***" (emphasis added), in re Morris, 127 F.3d 1048, 1054-55, 44 USPQ2d 1023, 1027-28 (Fed. Cir. 1997). Further, ***the claim must be interpreted in light of the teachings of the written description and purpose of the invention described therein.*** Strattec Sec. Co. v. Gen. Auto. Specialty Co., Inc., 126 F.3d 1411, 1417, 44 USPQ2d 1030, 1034-5 (Fed. Cir. 1997).

1.1 Rejection of Claim 1:

The Office Action rejected independent claim 1 under 35 U.S.C. §102(e) based on the rationale that the **Appelt** reference discloses the Applicant's claimed "...system for **automatically** alerting a user to available information ..." (emphasis added).

In particular, the Office Action cites **Appelt** as disclosing **automatically** "identifying at least one person represented by the identified data" and "retrieving information relating to each identified person from at least one electronic database." Further, with respect to the applicants claimed element of "retrieving information relating to each identified person from at least one electronic database," the Office Action suggests **Appelt** discloses a capability for **user queries** to initiate the retrieval of information. The Office Action then continues by suggesting that **Appelt** discloses a capability for "notifying the user that the retrieved information is available" by simply sending the manually requested response to the user.

However, in stark contrast to the position advanced by the Office Action, the Applicants respectfully suggest that **Appelt** does **not** retrieve "information relating to each identified person from at least one electronic database" as disclosed and claimed by the Applicants. In particular, the Applicants describe and claim a system where one or more persons are **automatically** identified through parsing of electronic documents. This system then **automatically** retrieves information relating to those identified persons and **alerts** a user as to the availability of that data. In contrast, **Appelt** retrieves data relating to one or more persons only upon a **manual user query**.

For example, as clearly illustrated by Figure 2 of the Applicants patent application, and as explained by the Applicants in paragraphs 45-46:

"...the present invention uses the program modules illustrated in FIG. 2 to **automatically scan** or parse at least one electronic document 200 to find any data that represents at least one person using a scanning module

210. Once data representing a person has been found, an identification and data retrieval module 220 ***automatically identifies the person*** represented by the data by comparing that data to information contained in at least one ... electronic database... then ***automatically retrieves data*** ... from at least one ... electronic databases... Finally, once the relevant data for the person has been retrieved, an alert module 250 ***automatically notifies the user***, via a visible or audible alert, ***that the person has been identified, and that information relevant to that person is available.***" (emphasis added)

Similarly, as discussed in paragraph 54 with respect to Figure 3, the Applicants explain that "once a person has been identified (Box 350), data or information relevant to that person is ***automatically retrieved*** (Box 360) from at least one electronic database" (emphasis added).

Further, in the preamble of claim 1, the Applicants claim a "system for ***automatically*** alerting a user to available information" (emphasis added). Consequently, each of the steps comprising that system must be understood to be automatic as well, especially when this claim is interpreted in light of the specification, which clearly and unequivocally explains the automatic nature of the Applicants' claimed invention. In fact, one clear advantage of the Applicants invention over the invention disclosed by ***Appelt*** is that, unlike ***Appelt***, the Applicants do ***not*** require a user to manually format and enter query strings for locating and retrieving information relating to particular identified persons. In fact, rather than being forced to manually enter query strings for retrieving data, the user is simply ***automatically*** notified of the availability of data relating to each identified person.

Further, with respect to the suggested capability of ***Appelt*** for "notifying the user that the retrieved information is available," the Applicants respectfully suggest that those skilled in the art would not interpret ***Appelt*** capability to provide a response to a

manually entered user query to disclose an ***automatic notification of available data*** as disclosed and claimed by the Applicants.

Therefore, in view of the preceding discussion, it is clear that the present invention, as claimed by independent claim 1, has elements not taught in the ***Appelt*** reference. Consequently, the rejection of claim 1 under 35 U.S.C. §102(e) is not proper. Therefore, the Applicants respectfully traverse the rejection of claim 1, and thus of dependent claims 2-9, 11, and 13-15 under 35 U.S.C. §102(e) in view of the novel language of claim 1.

In particular, claim 1 includes the following novel language:

A system for ***automatically*** alerting a user to available information comprising:

parsing an electronic document, said electronic documents including any of a word processor document, an Internet Web page, a spreadsheet, and any textual and graphical data rendered on a display device, to identify data representing any person;

identifying at least one person represented by the identified data;

retrieving information relating to each identified person from at least one electronic database; and

notifying the user that the retrieved information is available.

(emphasis added)

1.2 Rejection of Claim 2:

The Office Action rejected dependent claim 2 under 35 U.S.C. §102(e) based on the rationale that the ***Appelt*** reference discloses “automatically providing at least one communication access point ***related to the retrieved information.***” The Office Action cites ***Appelt***, Fig. 12, as describing this capability. However, the Applicants would like to point out that Fig. 12 of the ***Appelt*** reference is simply a generic block diagram of a

computer that does nothing whatsoever to disclose automatic communication access points ***related to the retrieved information***.

In contrast, throughout the Applicants specification, see paragraphs 21 and 69, for example, the Applicants describe and define communication “access points” as including, for example, “an email address, an instant messaging account, a telephone number, a fax number, a physical address, or any other means or method of communication with, or access to, the person that provides the user an access point for monitoring and/or initiating communication with that person.” Clearly, in the context of the description provided by the Applicants, the ***automatically provided*** communication access points provide the user with an ***automatically generated interface*** for initiating communications with persons that are ***automatically*** identified within an electronic document. This automatic capability is not disclosed by ***Appelt***, and is in no way suggested by the generic block diagram of a computer provided by Fig. 12 of the ***Appelt*** reference. Further, also in contrast to the position advanced by the Office Action, the Applicants respectfully suggest that the fact that the generic computer of Fig. 12 of the ***Appelt*** reference is connected to a network such as the Internet (as described in col. 12, lines 48-67) does nothing to disclose a capability to automatically provide the communication access points described and claimed by the Applicants.

Therefore, in view of the preceding discussion, it is clear that the invention of dependent claim 2 has elements not taught in the ***Appelt*** reference. Consequently, the rejection of claim 2 under 35 U.S.C. §102(e) is not proper. Therefore, the Applicants respectfully traverse the rejection of claim 2, and thus of further dependent claims 3-4 under 35 U.S.C. §102(e) in view of the novel language of claim 2.

In particular, claim 2 includes the following novel language:

“The system of claim 1 further comprising ***automatically providing at least one communication access point related to the retrieved information***” (emphasis added).

1.3 Rejection of Claims 7-8:

Dependent claims 7-8 are generally directed towards identifying “**graphical data** associated with any person” such as an image. The Office Action suggests that the **Appelt** reference discloses this capability, and offers col. 5, lines 13-18 of the **Appelt** reference in support of this suggestion. However, as discussed above, in col. 5, lines **13-20**, **Appelt** explains that **text capture** from a media source is accomplished using a suitable converter, such as a “speech recognizer” or a “closed-caption decoder.” Neither of these embodiments suggested by **Appelt** discloses a capability to identify graphical data. In fact, it should be clear that the identification of **graphical data** is *not* disclosed by a capability to parse or scan **text data**.

Therefore, in view of the preceding discussion, it is clear that the present invention, as claimed by dependent claims 7-8, has elements not taught in the **Appelt** reference. Consequently, the rejection of claims 7-8 under 35 U.S.C. §102(e) is not proper. Therefore, the Applicants respectfully traverse the rejection of claims 7-8 under 35 U.S.C. §102(e) in view of the novel language of claims 7-8 which clearly recite and claim the identification of **graphical** data rather than **textual** data as disclosed by **Appelt**.

1.4 Rejection of Claim 24:

The Office Action rejected independent claim 24 under 35 U.S.C. §102(e) based on the rationale that the **Appelt** reference discloses the Applicants claimed “...computer-implemented process for **automatically** providing information on a computer display device ...” (emphasis added).

In particular, the Office Action cites **Appelt** as disclosing **automatically** “scanning electronic data **being rendered on the computer display device** to identify information within the electronic data that represents at least one person” (emphasis added). The Office Action offers col. 5, lines 37-43 as disclosing the capability to scan

electronic data being rendered on the computer display device. However, the text in question clearly explains that:

“During a set-up phase, the information extraction engine 108 **parses free-text documents** to identify topics (events and relationships of interest) and objects (people, organizations and locations, among others) involved in those events and relationships. The topic and associated objects are defined and constructed by an analyst when the system 100 is set up, as discussed in more detail in FIG. 2.” (emphasis added)

In stark contrast, claim 24 includes the capability to **directly scan** information that is **rendered on a computer display device**. In view of detailed description provided in the Applicant’s specification, it should be clear that this is **not** interpreted to mean that data being scanned is then rendered on the display device, but that the Applicant’s system is **directly scanning the display device itself** to identify information being rendered on that display device which represents at least one person.

In contrast, the text of the **Appelt** reference cited by the Office Action merely describes scanning “free-text documents.” Further, while **Appelt** does suggest that text may be captured from a “multimedia source” (see col. 5, lines 13-20), **Appelt** explains that such text capture is accomplished using a suitable converter, such as a “speech recognizer” or a “closed-caption decoder.” Neither of these embodiments suggested by **Appelt** discloses a capability to actually **directly scan the display device itself** to identify information being rendered on that display device which represents at least one person.

Consequently, in view of the above discussion, it should be clear that the **Appelt** reference fails to disclose the Applicant’s claimed invention, as **Appelt** is clearly incapable of directly scanning electronic data being rendered on a display device for the purpose of identifying information within the electronic data that represents at least one person.

Further, as discussed above with respect to the rejection of independent claim 1, it should be clear that the **Appelt** reference fails to disclose the Applicants claimed elements of “**retrieving information relating to each identified person** from at least one electronic database” and “**providing an alert for indicating that the retrieved information is available**” (emphasis added).

Therefore, in view of the preceding discussion, it is clear that the present invention, as claimed by independent claim 24 has elements not taught in the **Appelt** reference. Consequently, the rejection of claim 24 under 35 U.S.C. §102(e) is not proper. Therefore, the Applicant respectfully traverses the rejection of claim 24, and of dependent claims 25-30 and 35-36 under 35 U.S.C. §102(e). Thus, the Applicant respectfully requests reconsideration of the rejection of claims 24-30 and 35-36 under 35 U.S.C. §102(e) in view of the proceeding discussion and in further view of the novel language of claim 24.

In particular, claim 24 recites the following language:

A computer-implemented process for automatically providing information on a computer display device, comprising:

scanning electronic data being rendered on the computer display device to identify information within the electronic data that represents at least one person;

identifying each person represented by the identified information;

retrieving information relating to each identified person from at least one electronic database; and

providing an alert for indicating that the retrieved information is available. (emphasis added)

1.5 Rejection of Claims 25 and 35:

As discussed above with respect to the rejection of dependent claim 2, the **Appelt** reference fails to disclose the communication “access points” as described and claimed by the Applicants. In particular, the **Appelt** reference fails to disclose “a user interface for initiating communications with the identified person via at least one **communication access point**” (emphasis added).

Therefore, in view of the preceding discussion, it is clear that the present invention, as claimed by dependent claims 25 and 35, has elements not taught in the **Appelt** reference. Consequently, the rejection of claims 25 and 35 under 35 U.S.C. §102(e) is not proper. Therefore, the Applicants respectfully traverse the rejection of claims 25 and 25 under 35 U.S.C. §102(e) in view of the novel language of claims 25 and 35 which clearly recite and claim automatic **communication access points** for initiating communication with identified persons.

1.6 Rejection of Claim 37:

The Office Action rejected independent claim 37 under 35 U.S.C. §102(e) based on the rationale that the **Appelt** reference discloses the Applicant's claimed “...computer executable instructions for dynamically modifying an electronic document **rendered on a computer display device...**”

In particular, the Office Action cites **Appelt**, col. 5, lines 37-43, as disclosing “detecting any information **in the electronic document** that represents at least one person.” However, **as specifically explained and discussed in the Applicants previous response**, the Applicant's again respectfully suggest that the plain meaning of claim 37 is that an “electronic document **rendered on a computer display device**” is automatically examined for “**detecting any information in the electronic document** that represents at least one person.” This detected information is then used for “identifying each person based on a comparison of the detected information to data in at

least one electronic database.” Finally, the Applicant’s claimed invention continues by “retrieving data related to each identified person from at least one electronic database; and dynamically modifying the electronic document by changing the appearance of the electronic document for alerting a user that data related to each identified person has been retrieved.”

Clearly, as with claim 24, claim 37 is describing a capability to ***directly scan*** information that is ***rendered on a computer display device***. In view of preceding discussion, and in further view of the detailed description provided in the Applicants’ specification, it should be clear that this capability is ***not*** disclosed by the ***Appelt*** reference which explains, in col. 5, lines 37-43, that “during a set-up phase, the information extraction engine 108 ***parses free-text documents...***” as disclosed by of the ***Appelt*** reference.

In fact, as described above, it should be clear that unlike the parsing of “free-text documents,” the Applicants’ claimed system is ***directly scanning the display device itself*** to identify information being rendered on that display device which represents at least one person. Thus, it should be clear that the ***Appelt*** reference fails to disclose the Applicants’ claimed capability for directly scanning a display device to automatically identify information that represents a person, and then to act on that information by identifying the persons and retrieving information relating to those identified persons.

Consequently, in view of the above discussion, it should be clear that the present invention, as claimed by independent claim 37 has elements not taught in the ***Appelt*** reference. Consequently, the rejection of claim 37 under 35 U.S.C. §102(e) is not proper. Therefore, the Applicants respectfully traverse the rejection of claim 37, and of dependent claims 38-45 and 50. Thus, the Applicant respectfully requests reconsideration of the rejection of claims 37-45 and 50 under 35 U.S.C. §102(e) in view of the proceeding discussion and in further view of the novel language of claim 37.

In particular, claim 37 recites the following language:

A computer-readable medium having computer executable instructions for dynamically modifying an electronic document ***rendered on a computer display device***, said computer executable instructions comprising:

detecting any information in the electronic document that represents at least one person;

identifying each person based on a comparison of the detected information to data in at least one electronic database;

retrieving data related to each identified person from at least one electronic database; and

dynamically modifying the electronic document by changing the appearance of the electronic document for alerting a user that data related to each identified person has been retrieved. (emphasis added)

2.0 Rejections under 35 U.S.C. §103(a):

In the Office Action of September, 2003, claims 10 and 12 were rejected under 35 U.S.C. §103(a) as being unpatentable over ***Appelt***. In addition, claims 16-23, 31-34 and 46-49 were rejected under 35 U.S.C. §103(a) as being unpatentable over ***Appelt*** in view of Appelman et al. ("***Appelman***," U.S. Patent 6,539,421).

In order to deem the Applicant's claimed invention unpatentable under 35 U.S.C. §103(a), a prima facie showing of obviousness must be made. However, as fully explained by the M.P.E.P. Section 706.02(j), to establish a prima facie case of obviousness, three basic criteria must be met. First, ***there must be some suggestion or motivation***, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, ***to modify the reference or to combine reference teachings***. Second, there must be a ***reasonable expectation of success***. Finally, ***the prior art reference (or references when combined) must teach or suggest all the claim limitations***.

Further, in order to make a prima facie showing of obviousness under 35 U.S.C. 103(a), ***all*** of the claimed elements of an Applicant's invention must be considered, ***especially when they are missing from the prior art. If a claimed element is not taught in the prior art and has advantages not appreciated by the prior art, then no prima facie case of obviousness exists.*** The Federal Circuit court has stated that it was error not to distinguish claims over a combination of prior art references where a material limitation in the claimed system and its purpose was not taught therein (*In Re Fine*, 837 F.2d 107, 5 USPQ2d 1596 (Fed. Cir. 1988)).

2.1 Rejection of Claims 10 and 12:

Claims 10 and 12 were rejected under 35 U.S.C. §103(a) based on the rationale that ***Appelt*** discloses the underlying parent claim, i.e., claim 1, and that the elements of the dependent claims, i.e., claims 10 and 12 are obvious in view of ***Appelt***.

However, as discussed above with respect to the rejection under 35 U.S.C. §102(e) of independent claim 1, which is the parent claim of claims 10 and 12, ***Appelt*** fails to teach or describe all of the elements of the Applicant's claimed invention. Therefore, any attempt to reject dependent claims based on supposed obviousness of those claims is invalid where the parent claim is shown to be patentable over the cited art. Thus, because claim 1 has been shown to be patentable over the ***Appelt*** reference, dependent claims 10 and 12 must also be patentable over the ***Appelt*** reference.

Consequently, no prima facie case of obviousness has been established in accordance with M.P.E.P. Section 706.02(j) and in accordance with the holdings of *In Re Fine*. This lack of a prima facie showing of obviousness means that the rejected claims are patentable under 35 U.S.C. §103(a). The basis for this patentability is the nonobvious language of independent claim 1, as cited above. Therefore, the Applicants respectfully traverse the rejection of claims 10 and 12, and request reconsideration of

the rejection of claims 10 and 12 under 35 U.S.C. §103(a) over **Appelt** in view of the non-obviousness of claim 1.

2.2 Rejection of Claims 16-23:

Claims 16-23 were rejected under 35 U.S.C. §103(a) based on the rationale that **Appelt** discloses the underlying parent claim, i.e., claim 1, and that the elements of the dependent claims, i.e., claims 10 and 12 are obvious over **Appelt** in view **Appelman**.

However, as discussed above with respect to the rejection under 35 U.S.C. §102(e) of independent claim 1, which is the parent claim of claims 16-23, **Appelt** fails to teach or describe all of the elements of the Applicant's claimed invention. Therefore, any attempt to reject dependent claims based on supposed obviousness of those claims is invalid where the parent claim is shown to be patentable over the cited art. Thus, because claim 1 has been shown to be patentable over the **Appelt** reference, dependent claims 16-23 must also be patentable over the **Appelt / Appelman** combination where there is no valid rejection of the parent claim.

Consequently, no prima facie case of obviousness has been established in accordance with M.P.E.P. Section 706.02(j) and in accordance with the holdings of *In Re Fine*. This lack of a prima facie showing of obviousness means that the rejected claims are patentable under 35 U.S.C. §103(a). The basis for this patentability is the nonobvious language of independent claim 1, as cited above. Therefore, the Applicants respectfully traverse the rejection of claims 16-23 and request reconsideration of the rejection of claims 16-23 under 35 U.S.C. §103(a) over **Appelt** in view of **Appelman** in view of the non-obviousness of claim 1.

2.3 Rejection of Claims 31-34:

Claims 31-34 were rejected under 35 U.S.C. §103(a) based on the rationale that **Appelt** discloses the underlying parent claims, i.e., claim 24 and claim 26, and that the

elements of the dependent claims, i.e., claims 31-34 are obvious over **Appelt** in view of **Appelman**.

However, as discussed above with respect to the rejection under 35 U.S.C. §102(e) of independent claim 24, which is the parent claim of claims 26 and 31-34, **Appelt** fails to teach or describe all of the elements of the Applicant's claimed invention. Therefore, any attempt to reject dependent claims based on supposed obviousness of those claims is invalid where the parent claim is shown to be patentable over the cited art. Thus, because claim 24 has been shown to be patentable over the **Appelt** reference, dependent claims 31-34 must also be patentable over the **Appelt** / **Appelman** combination where there is no valid rejection of the parent claim.

Consequently, no prima facie case of obviousness has been established in accordance with M.P.E.P. Section 706.02(j) and in accordance with the holdings of *In Re Fine*. This lack of a prima facie showing of obviousness means that the rejected claims are patentable under 35 U.S.C. §103(a). The basis for this patentability is the nonobvious language of independent claim 24, as cited above. Therefore, the Applicant respectfully traverses the rejection of claims 31-34 under 35 U.S.C. §103(a) over **Appelt** in view of **Appelman** in view of the non-obviousness of claim 24. Thus, the Applicant respectfully requests reconsideration of the rejection of claims 31-34 in view of the novel language of claim 24, as cited above.

2.4 Rejection of Claims 46-49:

Claims 46-49 were rejected under 35 U.S.C. §103(a) based on the rationale that **Appelt** discloses the underlying parent claim, i.e., claim 37, and that the elements of the dependent claims, i.e., claims 46-49 are obvious over **Appelt** in view of **Appelman**.

However, as discussed above with respect to the rejection under 35 U.S.C. §102(e) of independent claim 37, which is the parent claim of claims 46-49, **Appelt** fails to teach or describe all of the elements of the Applicant's claimed invention. Therefore,

any attempt to reject dependent claims based on supposed obviousness of those claims is invalid where the parent claim is shown to be patentable over the cited art. Thus, because claim 37 has been shown to be patentable over the **Appelt** reference, dependent claims 46-49 must also be patentable over the **Appelt / Appelman** combination where there is no valid rejection of the parent claim.

Consequently, no prima facie case of obviousness has been established in accordance with M.P.E.P. Section 706.02(j) and in accordance with the holdings of *In Re Fine*. This lack of a prima facie showing of obviousness means that the rejected claims are patentable under 35 U.S.C. §103(a). The basis for this patentability is the nonobvious language of independent claim 37, as cited above. Therefore, the Applicant respectfully traverses the rejection of claims 46-49 under 35 U.S.C. §103(a) over **Appelt** in view of **Appelman** in view of the non-obviousness of claim 37. Thus, the Applicant respectfully requests reconsideration of the rejection of claims 46-49 in view of the novel language of claim 37, as cited above.

CONCLUSION

In view of the above, it is respectfully submitted that claims 1-50 are in immediate condition for allowance. Accordingly, the Examiner is respectfully requested to withdraw the outstanding rejection of claims 1-50 and to pass this application to issue. Additionally, in an effort to further the prosecution of the subject application, the Applicant kindly invites the Examiner to telephone the Applicant's attorney at (805) 278-8855 if the Examiner has any questions or concerns.

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